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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHERKAT, AREZOO

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,010

Applicant(s)

MESSERGES ET AL.

Examiner

Arezoo Sherkat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

This office action is responsive to Applicant's amendment received on Jan 19, 2005. Claims 1, 20, 23-24, 31-32, 36, and 46-47 are amended. Claims 1-53 are pending.

Response to Arguments

Applicant's arguments filed January 19, 2005 have been fully considered but they are not persuasive.

Applicants argue that "encrypted content" is not discussed by Sweet.

Examiner responds that Sweet's Cryptographic Key Management technology discloses digital contents which are encrypted using appropriate credentials (Page 13, Par. 0172). Sweet explains that the access codes are systematically assigned to the various secured portions of the system (i.e., domains) where each access code is adapted to be combined with other components to create a key for controlling access to the selected portions of the system (Page 14, Par. 0193).

Applicants also argue that "the cited reference is silent as to any relationship of one or more "communication devices" relative to a domain".

Examiner responds that Sweet's Pxa^3 Model discloses a consumer-member account with appropriate credentials for his section of the club (i.e., domain) along with downloaded Pxa^3 member client application software for his "Player Devices" such as portable digital players or personal computers (Page 13, Par. 0172-0173).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15-32, 34-36, and 38-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Sweet et al., (U.S. Publication No.2002/0031230 and Sweet hereinafter).

Regarding claims 1, 18-19, 43, and 48-49, Sweet discloses a communication device operable in a domain-based digital rights management environment comprising:

a receiver, coupled to and controlled by the processing element, operable to receive incoming messages to the communication device, a transmitter, coupled to and controlled by the processing element, operable to transmit output messages of the communication device (Pages 14-15, Par. 0200 and 0211); and

a processing element, and a digital rights management module coupled to the processing element that controls operation of the communication device within the

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domain-based digital rights management environment, wherein the digital rights management module of the communication device in combination with a domain authority of the domain-based digital rights management environment is operable to selectively add the communication device to a domain having one or more communication devices that share a cryptographic key, which is associated with the domain, and thus permit the communication device to selectively receive and decrypt digital content based upon membership in the domain using the shared cryptographic key (Page 15, Par. 0212-0223 and Page 16, Par. 0229-0247 and Pages 23-24, Par. 0382-0397).

Regarding claim 2, Sweet discloses wherein the transmitter is a limited range transmitter having a limited communication range and operable to transit the digital content to a trusted communication device within the limited communication range (i.e., only domain members and those users authorized through trust relationships are able to decrypt the digital content)(Page 7, Par. 0090-0102).

Regarding claims 3, 28-29, 36, and 39, Sweet discloses wherein in response to receiving a user request, the digital rights management module causes the transmitter of the communication device to transmit to a domain authority a request to register the communication device into the domain, and wherein if the communication device is determined to have access to one or more valid cryptographic elements, the digital rights management module causes the receiver of the communication device to receive

over a communications channel the cryptographic key of the domain from the domain authority to link the communication device to the domain (i.e., generating a credential key using Diffie-Hellman standard key generation algorithm)(Pages 9-10, Par. 0131-0133).

Regarding claims 4, 26-27, and 51-53, Sweet discloses wherein the digital rights management module in combination with the domain authority removes the communication device from the domain, comprising:

in response to the request of the user of the domain to remove the communication device, the digital rights management module of the communication device causes the transmitter to transmit a request that the communication device be removed from the domain, in response to the request that the communication device be removed from the domain, the communication device receives from the domain authority via the secure communications channel a command to remove the cryptographic key of the domain from the communication device, and upon receiving the command from the domain authority, the digital rights management module of the communication device removes the cryptographic key of the domain (i.e., canceling a member's security profile of a former member)(Pages 12-13, Par. 0161-0168).

Regarding claims 5, 10-11, 20-21, and 44, Sweet discloses wherein in response to the digital rights management module of the communication device causing the transmitter to transmit a request for digital content, at least one of the digital rights

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management module of the communication device and the domain authority verifies authenticity of the domain, and wherein upon verification of the authenticity of the domain, the receiver of the communication device receives an encrypted form of the requested digital content that is bound to the cryptographic key of the domain in which the communication device is registered (i.e., the retrieved member token comprising encrypted member security profile information is wrapped within a data object conforming to the soft token requirements of the TECSEC CKM product before it can be used for encrypting/decrypting by the member)(Page 15, Par. 0212-0223 and Page 16, Par. 0229-0247 and Pages 18-19, Par. 0271-0283 and Pages 23-24, Par. 0382-0397).

Regarding claims 6-8, 12-13, 15-17, 22-24, 30-32, and 45-47, Sweet discloses wherein the digital rights management module of the communication device enforces usage rules associated with the requested digital content and received by the receiver in a content package containing the requested digital content (i.e., those users who are in possession of the specific set of credentials are able to decrypt those selectively encrypted embedded objects of the data object)(Pages 10-11, Par. 0141-0142 and Par. 0146-0147).

Regarding claims 9, 25, and 34-35, Sweet discloses wherein the digital right management module, in response to the transmitter of the communication device receiving a request from a second communication device of the domain requesting the

digital content, causes the transmitter to transmit the requested digital content from a storage element to the second communication device.

Regarding claim 38 and 40, Sweet discloses further comprising prior to receiving a request to add the communication device to the domain, the domain authority receiving a request to create the domain having a domain name and a domain password, the domain authority initiating the communications channel with the communication device, the domain authority determining a unique identification of the communication device, the domain authority establishing the domain using the unique identification of the communication device, the domain name, and the domain password, the domain authority creating the cryptographic key of the domain, and the domain authority providing the cryptographic key for download by the communication device (i.e., the retrieved member token comprising encrypted member security profile information is wrapped within a data object conforming to the soft token requirements of the TECSEC CKM product before it can be used for encrypting/decrypting by the member)(Pages 23-24, Par. 0382-0397).

Regarding claims 41 and 42, Sweet discloses further comprising the domain authority:

maintaining a log of requests by the communication device to register to or be deleted from one or more domains, monitoring the log to identify potentially fraudulent activity by the communication device, and generating a warning message in response to

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identifying potentially fraudulent activity by the communication device(i.e., monitoring/reporting/logging service module logs all meaningful events for billing, access control, and system monitoring use)(Page 16, Par. 0229-0245 and Page 19, Par. 0284-0299).

Regarding claim 50, Sweet discloses further comprising a second communication device of the one or more communication devices of the domain receiving digital legacy content from a source external to the domain and storing it in a storage element of the second communication device, and in response to a request from a third communication device of the domain, the second communication device transmitting the digital legacy content from the storage element to the third communication device (i.e., determining trust relationships with the other domains)(Page 6, Par. 0087-0088 and Pages 7-8, Par. 0090-0117).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweet et al., (U.S. Publication No.2002/0031230 and Sweet hereinafter), in view of Tokue et al., (U.S. Publication No. 2002/0002413 and Tokue hereinafter).

Teachings of Sweet with respect to claims 10, 29, and 36 have been discussed previously.

Regarding claims 14 and 33, Sweet does not expressly disclose wherein the digital rights management module of the communication device stores the encrypted digital content in an open-access storage element.

However, Tokue discloses wherein the digital rights management module of the communication device stores the encrypted digital content in an open-access storage element (Pages 3-4, Par. 0028-0036).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Sweet with the teachings of Tokue because it would allow to include wherein the digital rights management module of the communication device stores the encrypted digital content in an open-access storage element with the motivation to manage the distribution of user-purchased contents to the portable terminal player according to the SDMI rule (Tokue, Page 4, Par. 0036).

Regarding claim 37, Sweet does not expressly disclose wherein prior to the domain authority transmitting the cryptographic key to the communication device further comprising: the domain authority determining that the one or more communication devices of the domain do not exceed a predetermined upper limit.

However, Tokue discloses wherein prior to the domain authority transmitting the cryptographic key to the communication device further comprising: the domain authority determining that the one or more communication devices of the domain do not exceed a predetermined upper limit (Pages 4-7, Par. 0048-0074).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teachings of Sweet with the teachings of Tokue because it would allow to include wherein prior to the domain authority transmitting the cryptographic key to the communication device further comprising: the domain authority determining that the one or more communication devices of the domain do not exceed a predetermined upper limit with the motivation to manage the distribution of user-purchased contents to the portable terminal player according to the SDMI rule (Tokue, Page 4, Par. 0036).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Li, (U.S. Patent No. 6,606,706),

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arezoo Sherkat whose telephone number is (571) 272-3796. The examiner can normally be reached on 8:00-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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